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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,901	02/04/2002	Yoshiho Gotoh	MTS-710US26	5932

7590 06/20/2003
Ratner & Prestia
500 North Gulph Road
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EXAMINER

CALLAHAN, PAUL E

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 06/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/066,901

Applicant(s)

GOTOH ET AL.

Examiner

Paul E. Callahan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 19 August 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 6. 6) ☐ Other: _____

DETAILED ACTION

1. Claims 36 and 37 are pending in this application. Claims 1-35 have been cancelled by preliminary amendment.

Drawings

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 8-19-02 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

Double Patenting

3. Claims 36 and 37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,052,465. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim identical arrangements of a barcode and identifier on a disk. Although the claimed invention includes the limitation of the identifier and the information-bearing bar-code being in different locations on the disk whereas the instant application does not, the absence is not distinguishing since the identifier must of necessity be in a different location, even if just adjacent to the bar code, in order to be read and provide an indication of the presence of absence of the bar code.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,706,047 to Lentz et. al in view of US Patent 3,752,961 to Torrey and Official Notice taken as detailed below.

Lentz teaches an optical disk comprising a barcode like mark including a plurality of bars extending in a radial direction, in fig. 5 and fig. 6. Lentz does not teach inclusion of an identifier included in a control data area of an information area of a disk, for indicating whether or not said barcode is present or absent. Torrey does teach the use of an identifier used to indicate the presence or absence of a barcode, in fig. 1 item 4 "No Label Detector," and in claim 7 where an identifier sequence is used to denote the presence or absence of a bar code. Official Notice may be taken that the use of a control data area of a disk to write identifiers is a step that is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated these features of Torrey and of which Official Notice has been taken into the system of Lentz. It would have been desirable to do so as this would allow for more rapid processing of data by preventing a disk reader from having to scan an entire sector of a disk searching for a barcode not present, inclusion of an identifier in a control data

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area would facilitate greater information storage by not intruding on a data storage area of the disk.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (703) 305-1336.

The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron, can be reached on (703) 305-1830. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 Official Faxes, (703) 746-7240 Unofficial Faxes, and (703) 746-7238 After Final Faxes.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

6/13/03

Paul Callahan